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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/387,659 08/31/99 FITZGIBBON

J 66427

022242 MMC2/0425  
FITCH EVEN TABIN AND FLANNERY  
120 SOUTH LA SALLE STREET  
SUITE 1600  
CHICAGO IL 60603-3406

EXAMINER

SALATA, A

ART UNIT

PAPER NUMBER

2837

DATE MAILED:

04/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

09/387,659

Applicant(s)

FITZGIBBON ET AL.

Examiner

Jonathan Salata

Art Unit

2837

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
ASSISTANT SECRETARY AND COMMISSIONER OF PATENTS AND  
TRADEMARKS  
Washington, D.C. 20231

Paper No:14

Serial Number: 09/387659

Filing Date: August 31,1999

1. The request filed on 4-16-01 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/387659 is acceptable and a CPA has been established.

An action on the CPA follows.

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

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3. Claim 15-18 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 16-22 of prior U.S. Patent No. 5,998,950. This is a double patenting rejection.

While the grammar and syntax may be different, it is not seen where a different invention is present within the claimed invention and that of '950.

15,18) Garage Door;

The instant specification and that '950 is clearly directed towards that of garage doors. Note discussion of figure 1.

Sending a command...of open, close or stop movement

Claims 16,20,22 of '950 state "sending a first motor control command...raising, lowering or stopping the door"

Checking to determine whether the command is being correctly performed

Claims 16,20,22 of '950 states "detecting a malfunction...movement not in accordance with the first motor control command"

Generating a signal

Claim 16 of '950 states "sending fault control signals..."

Claims 20,22 state "sending a second motor control command..."

Controlling barrier movement

Claims 16,20,22 of '950 state "motor control circuitry which responds to motor control commands...sending fault control signals to the motor control circuitry"

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16) Stop command and checking to see if barrier has stopped

Claim 16 of '950 states "s nsing door mov ment...aft r first motor control command is sent"

Claim 22 states "door should be stopped"

17) Open barrier if not stopped

Claim 19 of '950 states "raising the door"

4. Applicant's arguments filed 4-16-01 have been fully considered but they are not persuasive. Claims in different applications need to be more than merely different in form or content and that a patentable distinction must exist to entitle applicant to a second patent. See MPEP 804.03

It cannot be seen where a different invention exists between the instant application and '950.

The substitution of structural equivalents such as "barrier" for "garage door" does not appear to define a "different invention".

The word "barrier" is not even present in the instant specification, which is clearly directed towards garage doors only.

The deletion of common structural elements in the claimed invention does not further provide a patentable distinction. Clearly the detection of a malfunction in the instant invention, is the detection of rotation of the motor after a command has been sent. The instant invention and the '950 patent both determine this by rotation when none is supposed to occur or rotation in the incorrect direction. Applicant appears to state that any

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other type of detection would not constitute double patenting. It is not seen where any other type of detection would be present nor would applicant be entitled to any future type of detection, which may be discovered. However, claims 16-22 do not state the switching means or windings. Claims 16,18-19,20,22 do not state the rotation sensing.

5. Any inquiry of a **general nature or relating to the status of this application or filed papers** should be directed to the **Group receptionist whose telephone number is (703) 308-0956.**

Papers related to this application may be submitted to Group 2800 by facsimile transmission. Papers should be faxed to Group 2800 via the PTO 2100 Fax Center located at Crystal Plaza 4. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 O.G. 30 (November 15,1989). The Group 2100 CP 4 Fax Center number is (703) 308-77(22 or 24).

For assistance in **Patent procedure, fees or general Patent questions** calls should be directed to the **Patents Assistance Center (PAC) whose telephone number is 800-786-9199.** Assistance is also available on the Internet at [www.uspto.gov](http://www.uspto.gov).

For requesting **copies of Cited Art, Office Actions or the like, or General Problem solving**, calls should be directed to the **TC 2800 Customer Service Office whose telephone number is 703-306-3329 or by fax at 703-306-5515.**

Any inquiry concerning **this communication or earlier communications from the examiner** should be directed to **Jonathan Salata whose telephone number is (703) 308-3120.** The examiner can normally be reached on Monday through Thursday from 6:30 am to 2:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Nappi, can be reached on (703) 308-3370.

ajs  
April 24, 2001

  
**JONATHAN SALATA  
PRIMARY EXAMINER  
ART UNIT 2837**